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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/541,795 03/31/00 LINK

J 6446.US.P2

023492
ABBOTT LABORATORIES
DEPT. 377 - AP6D-2
100 ABBOTT PARK ROAD
ABBOTT PARK IL 60064-6050

HM12/0627

EXAMINER

PATEL, S

ART UNIT

PAPER NUMBER

1624

DATE MAILED:

06/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
09/541,795

Applicant(s)
James Link et al.

Examiner
Sudhaker Patel

Art Unit
1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 31, 2000
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-26 are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-26, drawn to compounds, compositions, method of use and the first recited process of making generic Formula I Ar, R10, R11 are aryl, alkyl, chains, but not Heterocycle, classified in classes 558-568, subclasses various depending on the nature of various substituents R1, R2, R3, R4, R5 etc. If this group is elected further restriction/election will be required, and furthermore a single species for the elected invention with exact and specific values for Ar, RR1-R5, R10/R11 will be required.
 - II. Claims 1-26, drawn to compounds, compositions, method of use and the first recited process of making generic Formula I wherein Ar, R10/R11 **form heterocycle** and represent furan, pyran, thiopyran, thien, dioxane and their benzo-fused forms (i.e. No Nitrogen), classified in class 549, subclasses various depending on the nature of various substituents R1, R2, R3, R4, R5 etc. If this group is elected further restriction/election will be required, and furthermore a single species for the elected invention with exact and specific values for Ar, RR1-R5, R10/R11 will be required.

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- III. Claims 1-10, 11, 12-13, 16-24, drawn to compounds, compositions, method of use and the first recited process of making generic Formula I wherein Ar, R10/R11 **form heterocycle** and represent pyrrole, indole, imidazole, oxazole cores, classified in class 548, subclasses various depending on the nature of various substituents R1, R2, R3, R4, R5 etc. If this group is elected further restriction/election will be required, and furthermore a single species for the elected invention with exact and specific values for Ar, RR1-R5, R10/R11 will be required.
- IV. Claims 1-26, drawn to compounds, compositions, method of use and the first recited process of making generic Formula I wherein Ar, R10/R11 **form heterocycle** and represent pyridine, piperidine, quinoline cores, classified in class 546, subclasses various depending on the nature of various substituents R1, R2, R3, R4, R5 etc. If this group is elected further restriction/election will be required, and furthermore a single species for the elected invention with exact and specific values for Ar, RR1-R5, R10/R11 will be required.
- V. Claims 1-26, drawn to compounds, compositions, method of use and the first recited process of making generic Formula I wherein Ar, R10/R11 **form heterocycle** and represent pyrrole, to form heterocycle and represent pyrimidine, pyrazine, thiomorpholine cores, classified in class 544, subclasses various depending on the nature of various substituents R1, R2, R3, R4, R5 etc. If this

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group is elected further restriction/election will be required, and furthermore a single species for the elected invention with exact and specific values for Ar, RR1-R5, R10/R11 will be required.

- VI.** Claims 1-24, drawn to compounds not included in above **Groups I-V**. If this group is elected further restriction/election will be required, and furthermore a single species for the elected invention with exact and specific values for Ar, RR1-R5, R10/R11 will be required.

In addition to one of the above groups, applicants are further required to elect a single species embracing the elected group.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions **I-VI** are related as process of making and process of using the product. The use as claimed cannot be practiced with a materially different product. Since the product is not allowable, restriction is proper between said method of making and method of using. The product claim will be examined along with the elected invention (MPEP § 806.05(I)).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and the search required for **Group I** is not required for **Groups II-VI**, restriction for examination purposes as indicated is proper.

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5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. A telephone call was made to Ms. J. Strode on 6/19/01 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CAR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventor ship must be amended in compliance with 37 CAR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventor ship must be accompanied by a petition under 37 CAR 1.48(b) and by the fee required under 37 CAR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhaker Patel,D.SC. whose telephone number is (703) 308 4709. The examiner can normally be reached on Monday thru' Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Dr.Mukund Shah can be reached at (703) 308 4716.

A facsimile center has been established for Group 1600. The hours of operation Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or (703) 305-3592.

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Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308 1235.

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June 19, 2001.


Mukund J. Shah

Supervisory Patent Examiner

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